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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/584,347	05/24/2007	Hiroshi Koyamoto	51878	3340

1609 7590 05/04/2010
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WASHINGTON,, DC 20036

EXAMINER

FORTUNA, JOSE A

ART UNIT	PAPER NUMBER
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1791

MAIL DATE	DELIVERY MODE
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05/04/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/584,347	Applicant(s) KOYAMOTO ET AL.	
	Examiner José A. Fortuna	Art Unit 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) 5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of group I, claims 1-4 and 6 in the reply filed on March 2, 2010 is acknowledged.
2. Claim 5 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on March 2, 2010.

Claim Objections

3. Claim 6 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 6 is improper because it depends on a cancelled claim, claim 5.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-2 and 6 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ishiguro et al., US Patent No. 5,376,237 or Hasegawa et al. US Patent No. 6,571,951.

Both Ishiguro et al. and Hasegawa et al. teach printing papers, including newsprint, which is coated in both sides with a coating slip containing pigment(s) and at a coated grammage falling within the claimed range. They also teach smoothness falling the claimed range, see Ishiguro et al., abstract, column 3, line 66 through column 4, line 42 and Table 1; Hasegawa et al., abstract, (note that the oil absorption falls within the claimed range i.e., $4\text{mg}/\text{cm}^2$ and less than $7\text{mg}/\text{cm}^2$, which converts to 40 to less than $70\text{g}/\text{m}^2$), column 4, lines 10-30, where they show centerline average roughness value of 1.0 to $3.5\text{ }\mu\text{m}$, (which converts to 15.6 to 672.2

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seconds Bekk smoothness¹ $T_B = \left(\frac{8.76}{Ra} \right)^3$; wherein T_B is the Bekk Smoothness and Ra is the

Roughness centerline average); column 5, lines 48-64; column 4, lines 22-64. Note that that even though the cited references do not teach the measuring the oil absorptivity at any particular pressure, since the claims do not recite any pressure, then the oil absorptivity at atmospheric pressure reads on the claims and therefore, the references reads on the claims as claimed or at least the minor modification to obtain the claimed invention would have been obvious to one of ordinary skill in the art. Note that the papers of the cited references would at the very least have similar properties as the claimed one, since they are make using the same raw materials and the same or very similar process of making.

8. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishiguro et al. or Hasegawa et al. in view of Nisogi et al., US Patent Application Publication No. 2005/0016701 A1 or Tadakoro et al. in EP 1001082 A1 and EP 1016755 A2.

The primary references do not explicitly teach the use fiber binding inhibiting agents. However, the secondary references, Nisogi et al., Tadakoro et al., teach paper bulking agents, same as claimed, to improve printability and voluminousness in coated, see abstracts and paragraph [0002] of the EP'082 and abstract and paragraphs [0002] through [0005] of the EP'755. Also, Nisogi et al. teach that using such bulking agents the bulk is maintained, while improving smoothness, print gloss, and smaller small-scale gloss variation, see ¶-[0027], [0033]-[0034]. Therefore, using the bulking agents suggested by the secondary references, Nisogi et al., EP'082 and EP'755, would have

¹ The conversion factor is given by Enomae et al., in "Characteristics of Parker Print-Surf roughness as compared

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been obvious to one of ordinary skill in the art in order to obtain the advantages discussed above.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure in the art of "Coated Newsprint Papers."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to José A. Fortuna whose telephone number is 571-272-1188. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/José A Fortuna/
Primary Examiner
Art Unit 1791

JAF